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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,835	11/14/2003	C. Barclay Whitmore	56463-00006USPT	2576

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EXAMINER

SAVAGE, MATTHEW O

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,835

Applicant(s)

WHITMORE ET AL.

Examiner

Matthew O. Savage

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7 and 9-31 is/are pending in the application.
4a) Of the above claim(s) 12-25 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3,5-7,9-11 and 26-31 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6-23-06.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

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Applicant is advised that should claim 26 be found allowable, claim 28 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claim 29, the concept of the gasket for sealing the head against the filtration canister being formed of stainless steel and a fluid impervious washer formed of nitrile material is considered new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 26 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 26 and 28, it is unclear as to what type of plating "Commercial Bright nickel Plating" comprises.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 9, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over DePaul et al in view of Winslow et al and Whitmore.

With respect to claim 1, DePaul et al disclose a filtration canister 122 for filtering particulates from the fluid (see FIG. 12); and a separate evaporation canister 152 (see FIG. 16) for removing liquid contaminants by evaporation; the filtration canister further including a cylindrical container 123, a filter element 138 for removing the particulates from the fluids the filtration canister adapted for receiving one of a plurality of sizes of the filter element and for receiving fluid via a pipe connection; a head 126 for sealing an upper portion of the container, and means for securing and sealing the head and the filter element therein without allowing fluid to bypass the filter element (e.g., the

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threaded connection. DePaul et al fail to specify a threaded stud for securing the head and the container, and a centering spring for securing the filter element around the threaded stud. Winslow et al disclose a filter including a threaded stud 21 for securing a head 11 to a container, and a centering spring 37 for securing a filter element 19 around the threaded stud, and suggests that such an arrangement is capable of removing sludge from the oil. It would have been obvious to have modified the apparatus of DePaul et al so as to have included the filter as suggested by Winslow et al in order to remove sludge from lubricating oil. DePaul and Winslow et al fail to specify the details of the evaporation canister. Whitmore discloses an evaporation canister including an evaporator cup 26 housed within a container 12 of the evaporation canister for receiving the fluid, the evaporator cup includes a heating wand 29 and a base adapted to allow the fluid to pool at the base causing the fluid to disperse over a large surface area (see lines 33-42 of col. 2), the container being adapted to receive the fluid via an orifice 22 located below the heating wand, the heating wand 26 adapted to heat the fluid in the evaporator cup, and fluid flowing underneath the heating wand and engulfing the heating wand thereby facilitating evaporation of the liquid contaminants. Whitmore suggests that such an arrangement increases the efficiency of the evaporator. It would have been obvious to have modified the combination suggested by DePaul et al and Winslow et al so as to have included the details of the evaporator as suggested by Whitmore in order to increase the efficiency of the evaporator.

Concerning claim 2, DePaul et al and Winslow et al disclose filters adapted for filtering oil.

As to claim 3, DePaul et al and Winslow et al discloses filters adapted for filtering hydraulic fluid since oil is a form of hydraulic fluid and both DePaul et al and Winslow et al disclose filters capable of filtering oil.

Regarding claim 5, Winslow et al disclose the head of the canister as including a compression ring 18 for pressing against a portion of the filter element, a first orifice 12 for receiving oil from an engine, a second orifice 17 for receiving filtered oil, and a gasket for sealing the head against the filtration canister (see FIG. 1).

Regarding claim 9, Whitmore et al disclose the evaporator cup as including exterior ridges 32 for impeding the flow of the fluid.

With respect to claim 30, Winslow discloses the head as including an outer raised edge that is oriented to be placed inside the container (see FIG. 1)

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over DePaul et al in view of Winslow et al and Whitmore as applied to claim 1 above, and further in view of Kucik.

DePaul et al, Winslow et al, and Whitmore fail to specify a valve adapted for sampling fluid during fluid flow into the filtration canister. Kucik discloses a valve 7 capable of sampling fluid during fluid flow into a filtration canister and teaches that such a valve facilitates the drainage of oil from the canister to prevent the spillage of oil when removing the canister. It would have been obvious to have modified the combination suggested by DePaul et al, Winslow et al, and Whitmore so as to have included the valve as suggested by Kucik in place of the drain plug 34 of Winslow et al in order to

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facilitate drainage of oil from the canister to prevent the spillage of oil when removing the canister.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over DePaul et al in view of Winslow et al and Whitmore as applied to claim 1 above, and further in view of Wheeler.

DePaul, Winslow et al, and Whitmore fail to specify a shut-off valve for preventing flow of fluid into the filtration canister. Wheeler discloses a shut-off valve for preventing the flow of oil into a filtration canister 26 and suggests that such an arrangement enables changing of the filter element without interrupting engine operation. It would have been obvious to have modified the combination suggested by DePaul et al, Winslow et al, and Whitmore and so as to have included the shut-off valve as suggested by Wheeler in order to enable changing of the filter element without interrupting engine operation.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over DePaul et al in view of Winslow et al and Whitmore as applied to claim 1 above, and further in view of Landry.

With respect to claim 10, DePaul discloses a conduit for receiving and removing vaporized liquid contaminants from the evaporation canister but fails to specify a visual indicator for alerting a user as to whether electrical power is supplied to the heating wand. Landry broadly discloses the concept of providing a visual indicator in the form of

a light 27 for alerting a user as to whether electrical power is being provided to a heater 13. It would have been obvious to have modified the combination suggested by of DePaul et al, Winslow et al, and Whitmore so as to have included a visual indicator for alerting a user as to whether or not electrical power is supplied to the heater as suggested by Landry in order to provide an indication of proper operation of the heating wand.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over DePaul et al in view of Winslow et al and Whitmore as applied to claim 1 above, and further in view of Schwalge.

Concerning claim 11, DePaul et al, Winslow et al, and Whitmore fail to specify a metering valve located between the filtration canister and the evaporation canister for selective positioning to control the fluid flow. Schwalge discloses the use of a metering valve 11 for controlling flow into an evaporation canister. It would have been obvious to have modified the combination suggested by DePaul et al, Winslow et al, and Whitmore so as to have included a metering valve as suggested by Schwalge in order enable the control of fluid flow into the evaporation canister.

Claims 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over DePaul et al in view of Winslow et al and Whitmore as applied to claim 1 above, and further in view of Connelly et al and Schneider.

DePaul et al, Winslow et al, and Whitmore fail to specify the container as being formed of nickel plated steel and the head as being formed of cast aluminum. Connelly et al disclose the combination of a steel container 5 and a cast aluminum head 4 and suggests that such a configuration reduces the weight of the filter. It would have been obvious to have modified the combination suggested by DePaul et al, Winslow et al, and Whitmore so as to have included a steel container and cast aluminum head as suggested by Connelly et al in order to reduce the weight of the filter. Connelly fails to specify cold rolled steel or 319 aluminum alloy, however, such a modification would have been obvious in order to optimize the strength of the filter housing for a particular application. DePaul et al, Winslow et al, Whitmore, and Connelly et al fail to specify the container as being formed of nickel plated steel. Schneider discloses forming a container 34 from nickel plated steel and suggests that the plating prevents corrosion of the container. It would have been obvious to have modified the combination suggested by DePaul et al, Winslow et al, Whitmore, and Connelly so as to have included a nickel plated container as suggested by Schneider in order to prevent corrosion of the container.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over DePaul et al in view of Winslow et al and Whitmore as applied to claim 1 above, and further in view of Priest.

DePaul et al, Winslow et al, and Whitmore fail to specify an orifice in the head for receiving wires that supply electrical power to the heating wand. Priest discloses that it

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is known to provide an orifice in the head 41 of an analogous apparatus for receiving wires that supply electrical power to a heater and suggests that such an arrangement facilitates connection of the wires to adjacent equipment. It would have been obvious to have modified the combination suggested by DePaul et al in view of Winslow et al and Whitmore so as to have included an orifice in the head for receiving wires of the heating wand as suggested by Priest in order to facilitate connection of the wires to adjacent equipment.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over DePaul et al in view of Winslow et al and Whitmore as applied to claim 1 above, and further in view of Crumrine et al.

DePaul et al, Winslow et al, and Whitmore fail to specify a gasket formed of stainless steel and a fluid impervious washer of formed of nitrile rubber. Crumrine et al disclose a gasket formed of metal (e.g., part 17) and a fluid pervious washer 18 formed of rubber and suggests that such a gasket is self centering with respect to a peripheral edge of the associated chamber thereby preventing extrusion of the gasket. It would have been obvious to have modified the combination suggested by DePaul et al, Winslow et al, and Whitmore so as to have included the gasket as suggested by Crumrine in order to provide a gasket that was self centering. Crumrine et al fail to specify the gasket as being formed of stainless steel and nitrile rubber, however, such a modification would have been obvious in order to increase the corrosion resistance and the oil resistance of the metal and rubber parts, respectively.

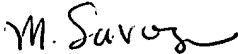
Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over DePaul et al in view of Whitmore.

With respect to claim 31, DePaul et al disclose a filtration canister 122 for filtering particles from a fluid (see FIG. 16), a separate evaporation canister 149 for removing liquid contaminants by evaporation, the evaporation canister including a container 151 for receiving the fluid and housing an evaporator 162, and a heating wand 155. DePaul et al fail to specify an evaporator cup as recited in the claim. Whitmore discloses an evaporator including a container 12 for receiving fluid and housing an evaporator including an evaporator cup 26 for receiving fluid via an orifice 22 located below a heating wand, the cup having an interior portion 30 and an exterior portion 28 and a base adapted to allow fluid to pool at the base causing the fluid to disperse over a large surface area (e.g., the outer wall of the cup, see lines 33-42 of col. 2), the heating wand 29 being adapted to heat the fluid to release liquid contaminants, the interior portion of the evaporator fills with heated fluid to a point at which it spills over the exterior portion of the evaporator cup, the fluid flowing underneath the wand and engulfing the heating wand, the purified liquid collecting at a lower portion 36 of the evaporation canister. Whitmore suggests that such an arrangement increases the efficiency of the evaporator. It would have been obvious to have modified the combination suggested by DePaul et al so as to have included the details of the evaporator as suggested by Whitmore in order to increase the efficiency of the evaporator.

Applicant's arguments filed 6-23-06 have been fully considered but they are not persuasive.

Applicant argues that Whitmore fails to disclose an evaporator cup having a base adapted to allow fluid to pool at the base causing the fluid to disperse over a large surface area, however, the reference clearly discloses such a limitation (see lines 33-42 of col. 2).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O. Savage whose telephone number is (571) 272-1146. The examiner can normally be reached on Monday-Friday, 7:00am-3:30pm.


Matthew O Savage
Primary Examiner
Art Unit 1724

mos
August 31, 2006